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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,897	05/24/2000	H. Robert Horvitz	01997/198007	5616
21559	7590	12/22/2003	EXAMINER	
CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110			SHUKLA, RAM R	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.	Applicant(s)	
09/577,897	HORVITZ ET AL.	
Examiner	Art Unit	
Ram R. Shukla	1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Applicants' response filed 9-17-2003 has been received and entered.
2. Claim 6 is pending.

#### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 6 is rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 5,962,301 for reasons of record set forth in the previous office action of 3-14-2003.

Applicants have stated that this rejection will be addressed after allowable subject matter has been indicated.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly

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connected, to make and/or use the invention for reasons of record set forth in the previous office action of 3-14-2003.

### ***Response to Arguments***

Applicant's arguments filed 9-17-2003 have been fully considered but they are not persuasive. Applicants have argued that applicants' specification is not required to teach what is known in the art and cite *United States v. Teletronics, Inc.* and that the applicants specification must not be considered in vacuum. In response applicants' attention is drawn to other case laws. For example,

Court also states, "It is true, as Genentech argues, that a specification need not disclose what is well known in the art. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986). However, that general, oft-repeated statement is merely a rule of supplementation, not a substitute for a basic enabling disclosure. It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. However, when there is no disclosure of any specific starting material or of any of the conditions under which a process can be carried out, undue experimentation is required; there is a failure to meet the enablement requirement that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art. It is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement." (See *Brenner v. Manson*, 383 U.S. 519, 536, 148 USPQ 689, 696 (1966))

Therefore, it is the specification that has to teach how to make and use claimed invention, not the art. In the instant case, the specification did not provide any specific disclosure how to make and use the claimed polypeptide. As noted in the previous office action, the specification only gave vague and general statements, no specific guidance. It is emphasized that at the time of the filing, the specification taught that the ced-3 protein was a target for a kinase and that it was required for cell death and except for the amino acid sequence, did not provide any guidance regarding its activity, how to produce it and how to use it. Later studies, however, have revealed that ced-3 is a protease and which proteolytically cleaves itself. This property of ced-3 protein was not known at the time of the filing and because of this property routinely used methods for producing recombinant proteins would not have been successful, as shown in Xue et al, where expression of the

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protein in bacteria produced three proteins, not one. This clearly indicates that producing the protein by routine methods would not have been predictable and the specification as filed did not produce any guidance how to make the protein.

Applicants argue that an artisan would have been able to express the protein in reticulocyte extract as taught by Hunter et al or Shapiro et al but the specification did not teach this method. Additionally, these papers are not relevant because they do not teach expressing a protease, which cleaves itself and therefore, one would not have expected to get full length protein using the reticulocyte method or any other method, as observed in the bacterial expression system used by Xue et al. Applicants then argue that Wu et al does not require a mutation to produce a full length ced-3 protein, rather Wu intentionally uses a mutant ced-3 for studying its interaction with ced-4. The issue is not: why Wu et al expressed a mutant protein, the issue is could an artisan have produced full length protein by following the directions in the specification and in view of the arts cited, an artisan would not have been successful in producing a full length protein due to the proteolytic properties of the protein. Next, applicants argue that the specification on page 3, lines 1 and 2, teaches that the protein could be used for generating antibody, however, in view of the unpredictability of producing a full length protein, an artisan would not have been able to produce antibody. Applicants argue that ced-3 could have been used for drug screening. Again, how could an artisan have carried out drug screening if the artisan could not produce full-length active protein.

In conclusion, an artisan of skill would have required extensive experimentation to make and use the claimed invention and in view of unpredictability of producing a full length protein as evidenced by the post filing art, an artisan would not have known what method to use for producing the protein and use it and therefore the experimentation would have been undue.

7. No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051. The fax phone number for TC 1600 is (703) 703-872-9306. Any inquiry of a general nature, formal matters or relating to the status of this application or proceeding should be directed to the William Phillips whose telephone number is (703) 305-3413.


Please note that effective January 13, the offices for Examiner Shukla, SPE Reynolds and LIE William Phillips will move to the new USPTO location in Alexandria, VA and their phone numbers will change. The new phone numbers will be as follows:

Ram Shukla: **(571) 272-0735**

Deborah Reynolds: **(571) 272-0734**

William Phillips: **(571) 272-0548**

Ram R. Shukla, Ph.D.  
Primary Examiner  
Art Unit 1632

  
**RAM R. SHUKLA, PH.D.**  
**PRIMARY EXAMINER**